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Supreme Court, U.S.
FILED
JUL 10 1990
JOSEPH F. SPANIOL, JR.
CLERK

No. 89-1866

IN THE

Supreme Court of The United States

October Term, 1989

FRANKLIN PIERCE LAW CENTER,
Petitioner

v.

GEORGETOWN UNIVERSITY,
Respondent

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

PETITIONER'S REPLY TO BRIEF IN OPPOSITION

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The respondent, in its brief in opposition to the petition for certiorari, states that this case involves only a mere "factual" dispute as to whether petitioner proved secondary meaning of its descriptive trademark, and that petitioner misconstrues the law and cases cited and has only manufactured a conflict of law, so that the attention of this Court is not warranted.

Respondent, however, concedes that petitioner *did comply* with the requirement of the trademark examining attorney for a showing of *statutory secondary meaning,* called *"distinctiveness"* (Sec. 2f of the Lanham Act)[1] and that the facts of such showing were true[1].

There Are No Facts In Dispute

Petitioner has relied on the facts found by the Board and summarized by the Court of Appeals and now again admitted by respondent in its brief; namely,

A. Petitioner was the *first* to create, adopt and use the mark "in 1976" and has used it continuously since that date on its journal[1].

B. Petitioner complied with the Patent Office requirement, enunciated by the trademark examining attorney (R.B.-Appendix p. 16a), to satisfy the Sec. 2f showing of *statutory distinctiveness* (secondary meaning), demonstrating over five years of exclusive and continuous use of the mark in commerce[2].

C. The trademark examining attorney held that respondent had so complied, and allowed and published the application for registration.

D. Respondent—*ten years after petitioner*—"in the spring of 1986", just appropriated petitioner's trademark and deliberately started to use it on a competing law journal[3].

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[1] Respondent's brief is herein referred to as "R.B.". R.B. p. 3 bottom, p. 4 top; Appendix-bottom p. 16a.

[2] R.B. p. 2, ". . . in 1976, when it (Franklin Pierce Law Center) began using the current subtitle, 'The Journal of Law and Technology' ". p. 6, "Use . . . on covers of applicant's journal since 1976".

[3] R.B. p. 3, "In the spring of 1986, Georgetown first published a journal with the title 'The Journal of Law and Technology' ".

E. Petitioner, in addition to its showing of *statutory distinctiveness* (secondary meaning), provided other showings conventional to *common law secondary meaning*[4]; namely, in respondent's words:

"1. Use of the words as either part of the title or subtitle on covers of applicant's journal since 1976;

2. The expenditure of $600,000 by Franklin Pierce on the journal as a whole since 1976;

3. Invoices and correspondence showing Franklin Pierce, as well as others, referring to applicant's journal using the words sought to be registered." (R.B. p. 6).

F. The Board and the Court of Appeals "succinctly stated that this evidence was not a scientifically accurate survey." (R.B., p. 5).

The Pressing Legal Question Before This Court

Almost ignored by respondent is the *real issue* before this Court:

Is a showing of "common law" secondary meaning required for protection of a descriptive trademark where there is *admitted full compliance* with the showing of *statutory* secondary meaning ("distinctiveness")—a route deliberately created by Congress for this *sole purpose* of protecting otherwise descriptive trademarks?

Congress listened to 22 years[5] of debate as to whether to provide for *statutory* secondary meaning as opposed to *common law* secondary meaning for descriptive marks, and decided to set at least a minimum *statutory* standard *(not strict common law)* by Sec. 2f.

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[4] Respondent takes issue with petitioner's assertion that the Court of Appeals did not follow the Board in holding the mark "generic". Clearly, if the mark were "generic", then, as correctly stated by the Board, "no amount or quality of evidence of distinctiveness can lead to registration of the common name of a thing . . . As such, they are unregistrable under Section 2(e)(1) of the Act." (A. 7a, 9a). The Court of Appeals clearly treated with requirements of secondary meaning which have absolutely no significance had the mark been generic.

[5] Commencing with hearings on S.2679, 68th Cong. 2d Sess.

Is the Congressional *statutory* secondary meaning with which petitioner admittedly fully complied and which the Patent and Trademark Examiner ruled sufficient, actually a dead letter, as this decision would seem to say?

Respondent Concedes 2nd Circuit Court of Appeals "Abrogates" Common Law Secondary Meaning Requirement In Appropriate Cases

And while charging that there is no confusion or conflict in the various courts[6] and that petitioner has misunderstood or misquoted the cases, and even manufactured a supposed conflict, even respondent admits that the Court of Appeals of the Second Circuit has *abandoned* the requirement of a showing of full common law secondary meaning, and indeed looked to the long exclusive use by a first-comer, totally analogous to the minimum *statutory* distinctiveness requirements of Sec. 2f.

Specifically, respondent concedes that (R.B. p. 8):

> "the Second Circuit has abrogated the requirement of showing distinctiveness or secondary meaning *only* where 'certain types of unfair practices may call for judicial remedies even though traditional secondary meaning and likelihood of confusion are not proven.' "

And then respondent states that such

> ". . . Second Circuit . . . decisions, however, make clear that the secondary meaning requirement is abrogated *only* if the claim at issue is one of deliberate palming off or deliberately unfair business practices".

But that is precisely what is involved in this very case.

By its own admission, respondent appropriated petitioner's exact mark *ten years later* ("in 1986", R.B. p. 3) and started competing with petitioner with a brand new law journal,

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[6] Contrary to respondent's criticism, petitioner seasonably raised the conflict of law issue before the Court of Appeals in its petition for rehearing.

deliberately[7] and prominently using petitioner's established mark (and, indeed, without even using respondent's name near or in association with the mark).[8]

Conclusion

Clearly petitioner has correctly represented to this Court that there is a real and pressing issue and current conflict of understanding in the law of the protection of descriptive marks that call out for prompt clarification by the Supreme Court in the national *(and international)* interest.

It is significant that respondent has not in the slightest taken issue with petitioner's assertion (p. 13 of the petition) that thousands of yearly descriptive—trademark registrants all over the country would appear to have been placed in jeopardy by this decision of the CAFC in view of PTO applicants' current reliance on the *statutory* exclusive and continuous five year use to establish "distinctiveness", as opposed to a requirement of proving common law "secondary meaning", let alone by a "scientific survey".

It is urged, accordingly, that the petition should be granted.

Respectfully submitted.

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[7] Respondent was put on notice of petitioner's much earlier and world-wide use of the mark, but *deliberately* went ahead anyway. (Joint App.-CAFC-p. 80)

[8] Joint App.-CAFC-p. 213.